

REMARKS

Claims 1-19 are present in the present application and have been subjected to restriction by the Examiner under PCT Rule 13.1 as follows:

- I. Claims 1-9 and 14-19, drawn to conotoxin peptides, compositions containing them and methods of their use.
- II. Claims 10-11 and 13, drawn to nucleic acids encoding conotoxins.
- III. Claim 12, drawn to antibodies directed against conotoxins.

The Examiner alleges that the inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. Specifically, the Examiner contends that the general concept of this application is directed to conotoxins comprising the sequence SGTVGR or a variant of such sequence wherein one or more amino acids have been substituted or modified. The Examiner states that because variants of the sequence SGTVGR are known in the art, e.g., conotoxins MVIIA, MVIIBGVIA and GIIIA, the general concept of this application cannot be considered as a special technical feature. The Examiner requires Applicants to elect a single invention to which the claims will be restricted.

In addition, the Examiner states that the instant claims are directed to the following patentably distinct compounds: peptides SEQ ID NO: 5-32, nucleic acids encoding each of these peptides and antibodies directed against each of these peptides. The Examiner requires Applicants to elect a single disclosed compound for prosecution to which the claims will be restricted if no generic claim is finally held to be allowable. The Examiner also requires Applicants to identify a list of all claims that read on the elected compound. The Examiner states that this election requirement shall not be construed as a species election, as these compounds do not share a common primary structure and appear to be patentably distinct.

In order to be fully responsive to the Examiner's requirements for restriction, Applicants provisionally elect, with traverse, to prosecute the subject matter of Group I, Claims 1-9 and 14-19, drawn to conotoxin peptides, compositions comprising conotoxin peptides and methods of using conotoxin peptides. In response to the second part of the restriction requirement, Applicants provisionally elect the peptide of SEQ ID NO: 5 for continued prosecution. It is further respectfully submitted that all claims of Group I, i.e., claims 1-9 and 14-19, read on the elected peptide of SEQ ID NO: 5. However, pursuant to 37 C.F.R. §§1.111 and 1.143, Applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

A requirement for restriction presupposes an analysis of the subject application in light of the rules governing this practice, i.e., 37 C.F.R. §1.499 and PCT Rules 13.1 and 13.2. PCT Rule 13.1, first sentence, states: "The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention")." (Emphasis added.)

Applicants submit that Groups I-III are related to each other to form one single inventive concept warranting examination in a single application. Specifically, it is respectfully submitted that a principal special technical feature of the present invention resides in the identification of conotoxin peptides of Group I. The nucleic acid molecules of Group II encode the conotoxin peptides of Group I thereby enabling the manufacture of the conotoxin peptides of Group I. The antibodies of Group III are directed against the peptides of Group I thereby permitting the purification and identification of the peptides of Group I. Therefore, it is apparent that Groups I-III are related to each other so as to form a single inventive concept. Groups I-III are merely different aspects of a single invention.

As to different peptide sequences as set forth in SEQ ID NOS: 5-32, these peptide sequences also relate to each other both in their structures and their functions. More specifically, the sequences of SEQ ID NO: 6-32 are derivatives of the peptide sequence of SEQ ID NO: 5, wherein one or more amino acids of SEQ ID NO: 5 have been substituted or modified. According to the present invention, the peptides of SEQ ID NOS: 5-32 have selectivity for N-type calcium channel. Therefore, it is respectfully submitted that the peptide sequences as set forth in SEQ ID NOS: 5-32 are also related to each other as different aspects of a single invention.

The courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973). This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade

and Tariffs (GATT), applicants are required to conduct simultaneous prosecution, as here, requiring excessive filing costs or to otherwise compromise the term of related patent assets.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public interest in the legitimacy of issued patents, Applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects in a unitary invention are claimed.

Finally, Applicants respectfully submit that a determination to make the pending restriction requirement final must evidence the patentable distinctness of the defined three groups, and the patentable distinctness of SEQ ID NOS: 5-32, one from the other, as presented by the Examiner.

In view of the foregoing comments, it is respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,



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